



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,611	09/27/2001	Eduardo Chi Sing	034298-121	7377

7590 05/21/2004

ROBERT E. KREBS
THELEN REID & PRIEST LLP
P.O. BOX 640640
SAN JOSE, CA 95164-0640

EXAMINER

BAXTER, JESSICA R

ART UNIT	PAPER NUMBER
----------	--------------

3731

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,611

Applicant(s)

SING ET AL.

Examiner

Jessica R Baxter

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004 and 02 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-11 and 15-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-11 and 15-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 02022004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. As stated in the previous Office Action, claims 7-11, 15 and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7 and 22 lack a transitional phrase. The claims have been examined as if the transitional phrase was "comprising".

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 7, 15, 16, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,161,034 to Burbank et al.

Regarding claims 7, 16, 21 and 22, Burbank discloses a method for performing a biopsy comprising removing tissue from a vascular site (Column 6 lines 7-38) and positioning a pledget of absorbable sponge material adjacent the vascular tissue site wherein the absorbable sponge material includes a contrasting agent substantially dispersed throughout said absorbable sponge material (Column 5 lines 29-46).

Art Unit: 3731

Regarding claim 15, Burbank discloses the step of locating the position of the vascular tissue site by detecting the contrast agent (Column 6 lines 7-38).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8, 9, 17, 18, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burbank et al. '034 in view of U.S. Patent No. 4,098,728 to Rosenblatt.

Burbank discloses the claimed invention except for the use of a water insoluble contrasting agent selected from the group of tantalum, tantalum oxide, barium sulfate, gold tungsten, platinum, and mixtures thereof. Rosenblatt teaches that water insoluble contrasting agents such as barium sulfate are suitable contrast agents to be incorporated into the body for later detection (Column 8 lines 22-64). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the sponge of Burbank with the specific water insoluble substance of barium sulfate since it is a well-known suitable material used in medical imaging.

7. Claims 10, 11, 19, 20 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burbank et al. '034 in view of U.S. Patent No. 5,624,685 to Takahashi et al.

Burbank discloses the claimed invention except for the selection of a water soluble contrasting agent from the group of metrizamide, iopamidol, iothalamate sodium, iodomide sodium, meglumine, and mixtures thereof. Takahashi teaches that water soluble contrasting

Art Unit: 3731

agents such as iopamidol and metrizamide are suitable substances to be mixed with a sponge-like material (gel) for image detection. These materials are preferred since they will not embrittle the resulting gel (Column 5 line 65-Column 6 line 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Burbank with the contrasting agents of Takahashi in order to not embrittle the sponge (gel), but still be able to detect the sponge with X-rays.

Response to Arguments

8. Applicant's arguments filed February 2, 2004 have been fully considered but they are not persuasive.

9. Applicant argues that the contrasting agent of Burbank '034 is not substantially dispersed throughout said sponge material. However, Burbank discloses that the "detectable material will be combined (e.g. mixed with, encapsulated by, suspended in, etc.) a material to remain present at the biopsy site" (Column 12 lines 31-33). Mixtures and suspensions indicate that the detectable material will be substantially dispersed throughout the material. In this case, the material is a sponge.

Therefore, the rejection over Burbank is proper.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

Art Unit: 3731

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

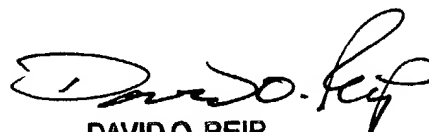
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica R Baxter whose telephone number is 703-305-4069. The examiner can normally be reached on M-F 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, McDermott or Shaver can be reached on 703-308-0858. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica R Baxter
Examiner
Art Unit 3731

jrb


DAVID O. REIP
PRIMARY EXAMINER